

REMARKS

Prior to entry of this Amendment and Response, claims 2-43 were pending in the application. The Examiner rejected claims 2-24 and 28-43 while objecting to claims 25-27. Following entry of this Amendment and Response, claims 2-10 and 12-42 will be pending.

Objection to the Drawings

The Examiner objected to Figure 1, alleging it should include a legend such as "--Prior Art--," insofar as only that which is old is illustrated. The Applicant has amended Figure 1 accordingly.

Allowable Subject Matter

The Applicant notes with appreciation the Examiner's indication that claims 2-9, 11-14, 18-20 and 28-39 would be allowable if rewritten as independent claims including the limitation of the base claim and any intervening claims, as well as being rewritten to overcome the § 112 rejections set forth by the Examiner.

The Applicant further notes with appreciation the Examiner's indication claim 43 would be allowable if rewritten in independent form and the aforementioned objections under § 112 were addressed. The Applicant respectfully submits claim 41 was amended to include the limitations of claim 43, and further that the § 112 objection raised by the Examiner has also been addressed. Accordingly, the Applicant respectfully submits claim 41, as amended, is allowable.

Rejections Under 35 U.S.C. § 112

1. Written Description

The Examiner rejected claims 11 and 43 under 35 U.S.C. § 112 as failing to comply with the written description requirement. Specifically, the Examiner alleged these claims contain subject matter not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor was in possession of the claimed invention, at the time the

application was filed. The Applicant respectfully traverses this rejection for at least the following reasons.

Initially, claims 11 and 43 have been cancelled. Accordingly, the Examiner's rejection of these claims are rendered moot. The function of the contamination prevention means set forth in these claims is similar to that now recited in claim 41.

Accordingly, to address any similar objections that may be raised against amended claim 41, the Applicant has amended the specification to more explicitly state "[t]he disposable contamination prevention means may thus isolate the illumination source from the insufflation means suffusing the lumen." This is shown in generally in Figs. 2-14, and more specifically in Fig. 15. The specification, as filed, describes this embodiment generally throughout pp. 16-18, and specifically in the paragraph amended, above. Thus, the Applicant respectfully submits no new matter is added to the specification by this amendment. Rather, the amendment merely sets forth in more explicit terms that which was already in possession of the Applicant and described on the date of filing.

Given this amendment, the Applicant respectfully submits claim 41, as amended, is fully supported by the specification.

2. Failure to Distinctly Claim Invention

The Examiner rejected claims 11, 18-20, 38, 40 and 43 under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In short, the Examiner alleged claims 11 and 43 recite a function of the contamination prevention means not described in the specification, namely, preventing contamination of a light source. The Applicant respectfully submits, for the reasons given above in the section entitled "*1. Written Description*," that claims 11 and 43 do distinctly claim the invention(s) in question.

The Examiner further alleges claims 11 and 43 are redundant, at least with respect to the operation of the contamination prevention means. The Applicant has cancelled these claims.

The Examiner rejected claims 18, 19, and 20 as lacking antecedent bases for "the contamination prevention means," insofar as each depends from claim 10 (among other claims). Claim 10 depends from amended claim 41, which now recites a "contamination prevention

means.” Accordingly, claims 18-20 recite the proper antecedent basis with respect to all claims from which they depend.

The Examiner rejected claim 38 for use of the relative term “good.” Claim 38 has been amended to remove the term.

The Examiner rejected claim 40 for reciting an additional “insufflation means.” The Applicant has amended claim 40 to clarify the insufflation means of claims 40 and 41 are the same.

The Examiner rejected claim 43 as reciting a function of the contamination prevention means not clearly described in the specification. The Applicant has cancelled this claim.

Rejections Under 35 U.S.C. § 102(b)

1. The Fiore Reference

The Examiner rejected claims 10, 15-17, 21, 22, 23, 24, 40, 41 and 42 under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 3,889,661 (“Fiore”). For at least the following reasons, the Applicant respectfully traverses the rejection.

Amended claim 41 recites an “insufflation medium being conveyed directly from the insufflation means to the lumen... without contacting the light source.” The Applicant respectfully notes such a limitation was included in now-cancelled claim 43, indicated to be allowable by the Examiner if certain defects under 35 U.S.C. § 112 were addressed.

The Applicant respectfully submits Fiore contains no such teaching or suggestion. Rather, Fiore explicitly discloses that the insufflation medium passes through the light source. “Both suction and pressure is applied through a nipple or conduit 34 which projects from lighting head 21 [sic] and communicates to the interior of barrel 11 through an appropriate opening or slot 35 (not shown) in cylindrical section 18” (col. 6, line 66 to col. 7, line 3).

Thus, the lumen is insufflated by means of a conduit passing directly through the light source/head, as shown to best effect in Fig. 1. By contrast, the invention claimed in independent claim 41 explicitly requires the insufflation medium *not* contact the light source. Fiore teaches away from the invention of claim 41. Accordingly, the Applicant respectfully submits Fiore cannot serve as a proper reference under 35 U.S.C. § 102(b) against the invention of claim 41, insofar as it does not anticipate every element of the claim.

Claims 10, 15-17, 21-24, and 40-42 all depend (directly or indirectly) from independent claim 41, which is patentable over Fiore. Accordingly, these claims are themselves patentable over Fiore. The Applicant makes this statement without reference to or waiving the independent bases of patentability within each of these dependent claims.

For all the foregoing reasons, the Applicant respectfully submits claims 10, 15-17, 21-24, and 40-42 are patentable over Fiore. The Applicant therefore respectfully requests the Examiner withdraw his rejection and allow these claims to issue.

2. The Saslow Reference

The Examiner rejected claims 41, 42, 10, 15-17, 21-24 and 40 under 35 U.S.C. § 102(b) as anticipated by United States Patent No. 3,889,661 to Saslow ("Saslow"). For at least the following reasons, the Applicant respectfully traverses the rejection.

Amended claim 41 recites an "insufflation medium being conveyed directly from the insufflation means to the lumen... without contacting the light source." The Applicant respectfully notes such a limitation was included in now-cancelled claim 43, indicated to be allowable by the Examiner if certain defects under 35 U.S.C. § 112 were addressed.

As shown in Fig. 1, the head of Saslow's speculum is provided with a lamp retainer 27 holding eight lamps 33. The lamp retainer "fits snugly within the cylindrical head of the instrument..." (col. 3, lines 26-30). An "air fitting nipple 47 is attached to the head," and air is pumped into the head through a hose or tube connected to the nipple (col. 3, lines 36-39; Fig. 1; col. 4, lines 53-56). An insufflation medium is pumped through the tube and nipple, and into the head of the speculum, in which the lamp retainer rests. *See* Fig. 3.

When air is pumped into the speculum, it necessarily passes across the lamp retainer, as shown in the exploded view of Fig. 3. Thus, the insufflation medium contacts the light source, in direct contrast to the language of amended claim 41. Specifically, claim 41 requires an "insufflation medium being conveyed directly from the insufflation means to the lumen... without contacting the light source." Accordingly, the Applicant respectfully submits Saslow cannot serve as a § 102 (b) reference against amended claim 41, insofar as it does not anticipate every element of the claim.

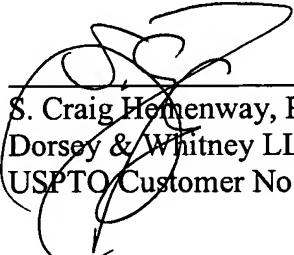
Conclusion

This Amendment and Response is submitted timely on July 6, 2004, the deadline to respond within the three-month shortened statutory period due to the Federal holiday falling on July 5, 2004. No petitions or fees are believed due at this time. However, if any such petition or fee is required, please consider this a request therefor and charge Deposit Account No. 04-1415 as necessary.

The Applicant thanks the Examiner for his thorough review of the claims in this application. Further, the Applicant submits that the application is now in condition for allowance, and respectfully request that the application be passed to allowance. In the event the Examiner has questions or comments and a telephone conversation would expedite a resolution, the Applicant invites the Examiner to contact the undersigned attorney at (303) 629-3400.

Dated this 6TH day of July, 2004.

Respectfully submitted:



S. Craig Hemenway, Reg. No. 44,759
Dorsey & Whitney LLP
USPTO Customer No. 20686

SCH/sd